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EXAMINER

BOVEJA, NAMRATA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,705

Applicant(s)

MILTON, JOHN R.

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to communication filed on 12/16/2005.
2. Claims 1-23 are presented for examination.

Objections

3. The claims are objected to because of the following informalities. Claims 1 and 7 recite ***“the at least one”*** and should recite ***“at least one”*** instead. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-22, are rejected under 102(e) as being anticipated by Kramer et al (Patent Number 6,327,574 hereinafter Kramer).

In reference to claims 1, 9, and 17, Kramer discloses a method, program, and system for populating at least one region in a publication, comprising: *analyzing a work order comprising a template identifier associated with the publication and a plurality of content-item identifiers identifying content items for populating a template (abstract, col. 3 lines 1-9, col. 7 lines 4-8 and 21-53, col. 7 lines 55 to col. 8 lines 8, col. 8 lines 24-66, col. 13 lines 5-19, col. 15 lines 22-62, col. 21 lines 51-61, col. 30 lines 60 to col. 33 lines*

47, and Figures 4, 5A, 5B, and 14-18); retrieving the template (i.e. a document or file having a preset format, used as a starting point for a particular application so that the format does not have to be recreated each time it is used) associated with the template identifier, the template defining the at least one region (col. 7 lines 55 to col. 8 lines 8, col. 8 lines 24-66, col. 31 lines 1-38, and Figures 4, 5A, 5B, and 14), the template further comprising an information identifier indicative of a type of content (i.e. a customized coupon, a customized webpage, a credit card statement with advertisements) item for populating the at least one region; determining, based upon the type of content item, a number of content items for populating the at least one region in the publication (col. 8 lines 1-8 and lines 41-66, col. 31 lines 1-38, col. 32 lines 25 to col. 33 lines 26, and Figures 4, 5A, 5B, and 14); associating a priority with each of a number of content items to be populated into the at least one region of the publication in a computer system (col. 23 lines 15 to col. 24 lines 35 and Figure 10); and populating the at least one region with *at least one of the number of* content items in an order corresponding to the priority associated with each of the content items (col. 30 lines 61 to col. 61-67).

6. In reference to claims 2, 10, and 18, Kramer teaches the method, program, and system further comprising identifying the number of content items with which to populate the at least one region of the publication (col. 31 lines 6 to col. 32 lines 23).

7. In reference to claims 3, 11, and 19, Kramer teaches the method, program, and system further comprising discarding select ones of the content items that do not fit within a remaining unpopulated portion of the at least one region (i.e. due to the limited

space on for example a credit card statement that is allocated to each merchant, there is insufficient space for displaying all the content, so the content can be cycled through by using a content rotator or a hyperlink that opens up the detailed content in a separate browser window, or the content can be discarded if the website owner such as the MultiBank in the case of the reference decides to implement a policy of having only a specific number of lines in the bank statement being illuminated with advertisements and leaving the rest of the lines blank and/or only allowing certain merchants to illuminate their statement lines) (col. 21 lines 48-50, col. 31 lines 18-52, and Figures 15-18).

8. In reference to claims 4 and 12, Kramer teaches the method, program, and system, further comprising shortening select ones (i.e. show a detailed set of books for children by age in a new browser window as seen in Figure 18 after showing the broader category of children's books in general at first due to a line advertising space limitation in the original browser window of Figure 14 for each content provider) of the content items that do not fit within a remaining unpopulated portion of the at least one region (col. 21 lines 48-50, col. 32 lines 24 to col. 33 lines 20 and Figures 17 and 18).

9. In reference to claims 5, 13, and 20, Kramer teaches the method, program, and system, further comprising resolving a priority conflict between at least two of the content items having a same priority associated therewith (i.e. each illumination could have a match score between 0 and 1, and therefore two can have the same match score and could then both be displayed in turns by using the star button which would show the second illumination upon clicking by the user, or, one could be displayed in

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one section of the screen and the other illumination could be displayed at another section of the screen simultaneously) (col. 7 lines 29-53 and col. 31 lines 6-38).

10. In reference to claims 6, 14, and 21, Kramer teaches the method, program, and system, further comprising: identifying a preference associated with select ones of the content items (col. 8 lines 14-63 and col. 32 lines 24 to col. 33 lines 26, Figures 5A, 5B, 17, and 18) and adjusting the priority associated with the select ones of the content items based upon the preference (col. 8 lines 14-63 and col. 32 lines 24 to col. 33 lines 26, Figures 5A, 5B, 17, and 18).

11. In reference to claims 7 and 15, Kramer teaches the method, program, and system, wherein the step of populating the at least one region with the content items in the order corresponding to the priority associated with each of the content items further comprises specifying the order to be from a highest priority to a lowest priority (col. 23 lines 15-22, col. 24 lines 16-35, and col. 32 lines 53-57).

12. In reference to claims 8 and 16, Kramer teaches the method, program, and system, wherein the step of identifying the number of content items with which to populate the at least one region of the publication further comprises identifying the content items based upon a predefined criteria provided by a user (i.e. when user volunteers information by performing certain actions, this becomes a predefined criteria provided by the user) (col. 10 lines 25-45, col. 12 lines 7-26, col. 13 lines 55-col. 15 lines 21, and col. 32 lines 45 to col. 33 lines 14).

13. In reference to claims 22 and 23, Kramer teaches the method and system for populating at least one region in a publication, comprising: identifying a number of

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content items with which to populate the at least one region of the publication in a computer system (i.e. this could be limit set by the owner of the website) (col. 31 lines 39 to col. 32 lines 2, col. 8 lines 41-63, and Figures 5A and 5B); associating a priority with each of the content items *based upon a consumer profile* (col. 7 lines 2-8 and 25-28, col. 8 lines 41-66, col. 21 lines 51-61, col. 32 lines 45 to col. 33 lines 38, and Figures 5A, 5B, and 14-18), identifying a preference *within a work order* (i.e. a work order comprises a number of content item references, a template reference, and a reader profile reference per applicant specification on page 8, and therefore this is referring to identifying a reader profile preference), the preference associated with select ones of the content items (col. 8 lines 14-63 and col. 32 lines 24 to col. 33 lines 26, Figures 5A, 5B, 17, and 18), adjusting the priority (i.e. showing the most relevant and appropriate messages first) associated with the select ones of the content items based upon the respective preferences (col. 8 lines 14-63 and col. 32 lines 24 to col. 33 lines 26, and Figures 5A, 5B, 17, and 18), populating the at least one region with the content items in an order corresponding to the priority associated with each of the content items (col. 7 lines 29-53 and col. 30 lines 61 to col. 32 lines 23), and discarding select ones of the content items that do not fit within a remaining unpopulated portion of the at least one region (i.e. due to the limited space on for example a credit card statement that is allocated to each merchant, there is insufficient space for displaying all the content, so the content can be cycled through by using a content rotator or a hyperlink that opens up the detailed content in a separate browser window, or the content can be discarded if the website owner such as the MultiBank in the case of the

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reference decides to implement a policy of having only a specific number of lines in the bank statement being illuminated with advertisements and leaving the rest of the lines blank and/or only allowing certain merchants to illuminate their statement lines) (col. 21 lines 48-50, col. 31 lines 18-52, and Figures 15-18).

Response to Arguments

14. After careful review of Applicant's remarks/arguments filed on 12/16/2005, the Applicant's arguments with respect to claims 1-23 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the specification and to the claims have both been entered and considered.

15. The 101 Rejection is being removed, since the Applicant's recitation of a program embodied in a computer readable medium in the preamble of the claims sufficiently addresses the issues previously raised by the Examiner in this case.

16. In reference to claims 1, 9, and 17, Applicant argues that Kramer does not disclose analyzing a work order comprising a template identifier associated with the publication and a plurality of content item identifiers identifying content items for populating a template, retrieving the template associated with the template identifier, the template defining the at least one region, the template further comprising an information identifier indicative of a type of content item for populating the at least one region and determining based upon the type of content item, a number of content items for populating the at least one region in the publication. The Examiner respectfully disagrees with the Applicant and would like to point out that the applicant specification on page 8 defines the work order to comprise a number of content item references, a

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template reference, and a reader profile reference per applicant specification on page 8, and Kramer teaches all of the components of this work order (abstract, col. 3 lines 1-9, col. 7 lines 4-8 and 21-53, col. 7 lines 55 to col. 8 lines 8, col. 8 lines 24-66, col. 13 lines 5-19, col. 15 lines 22-62, col. 21 lines 51-61, col. 30 lines 60 to col. 33 lines 47, and Figures 4, 5A, 5B, and 14-18). Furthermore, Applicant defines template in the specification on page 9 as providing layout information that is to be employed to create the resulting publication and including one or more regions into which content items are populated per applicant specification. Kramer teaches retrieving templates with identifiers (col. 7 lines 55 to col. 8 lines 8, col. 8 lines 24-66, col. 31 lines 1-38, and Figures 4, 5A, 5B, and 14), and determining, based upon the type of content item, a number of content items for populating the at least one region in the publication (col. 8 lines 1-8 and lines 41-66, col. 31 lines 1-38, col. 32 lines 25 to col. 33 lines 26, and Figures 4, 5A, 5B, and 14).

17. In reference to claims 22 and 23, Applicant argues that Kramer does not disclose associating a priority with each of the content items based upon a consumer profile, identifying a preference within a work order corresponding to the publication associated with select ones of the content items, and adjusting the priority associated with the select ones of the content items based upon the respective preferences. The Examiner respectfully disagrees with the Applicant, since Kramer teaches associating a priority with each of the content items based upon a consumer profile (col. 7 lines 2-8 and 25-28, col. 8 lines 41-66, col. 21 lines 51-61, col. 32 lines 45 to col. 33 lines 38, and Figures 5A, 5B, and 14-18), identifying a preference within a work order, the preference

associated with select ones of the content items (col. 8 lines 14-63 and col. 32 lines 24 to col. 33 lines 26, Figures 5A, 5B, 17, and 18), adjusting the priority associated with the select ones of the content items based upon the respective preferences (col. 8 lines 14-63 and col. 32 lines 24 to col. 33 lines 26, and Figures 5A, 5B, 17, and 18).

18. In reference to the remaining dependent claims 2-8, 10-16, and 18-21, and 16-21, since they are dependent upon the independent claims 1, 9, 17, 22, and 23, they are also rejected for substantially the same reasons as claims 1, 9, 17, 22, and 23 as detailed in the action above.

19. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

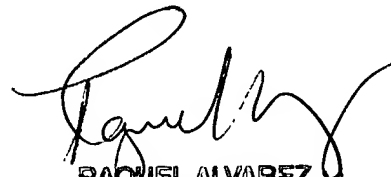
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

N.B.

February 17th, 2006


RAQUEL ALVAREZ
PRIMARY EXAMINER